

**REMARKS**

Applicants reply to the Office Action mailed on July 28, 2005, within the shortened statutory period for reply. Claims 1-19 were pending and the Examiner rejects claims 1-19. In reply, Applicants amend claims 1-2, 4, 6, 8-14 and 17-19, and address the Examiner's remarks. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter has been introduced by these amendments. Reconsideration of this application is respectfully requested.

The Examiner advised Applicants that under 37 C.F.R. § 1.56, Applicants are obligated to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made. Applicants respectfully assert that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made and therefore, Applicants have complied with 37 C.F.R. § 1.56.

**DOUBLE PATENTING**

Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 11, 44, and 12-21 of copending Applications Nos. 10/710,310, 10/710,311; over claims 1-7, 12, 44, and 13-22 of copending Application Nos. 10/710,315, 10/710,326, 10/710,328, and 10/710,329; over claims 1-7, 11, 43, and 12-21 of copending Application Nos. 10/710,317, 10/710,323, 10/710,324, 10/710,325, and 10/710,327; over claims 1-19 of copending Application No. 10/708,822; over claims 1-7, 13, 45, and 14-23 of copending Application No. 10/710,319; over claims 1-7, 11, 42, and 12-21 of copending Application No. 10/708,825; over claims 1-7, 11, 44, and 12-21 of copending Application No. 10/708,826; over claims 1-7, 12, 44, and 13-22 of copending Application Nos. 10/708,827, 10/708,833, 10/708,835, and 10/708,836; over claims 1-7, 11, 43, and 12-21 of copending Application Nos. 10/708,828, 10/708,830, 10/708,831, 10/708,832, and 10/708,834; and over claims 1-7, 13, 45, and 14-23 of copending Application No. 10/708,829.

Claims 1, 8, 11, and 19 are provisionally rejected as being unpatentable over claims 1, 6, 2, of copending Application No. 10/710,308; claims 1-4, 8, and 11 are provisionally rejected as being unpatentable over claims 1, 2, 4, 5, and 7 of copending Application No. 10/710,309; claims 1, 8, and 11 are provisionally rejected as being unpatentable over claims 1 and 6 of

copending Application No. 10/708,823; and claims 1-5, 8, and 11 are provisionally rejected as being unpatentable over claims 1-5 and 7 of copending Application No. 10/708,824.

While Applicants respectfully traverse these double patenting rejections, in the interest of compact prosecution, Applicants submit terminal disclaimers in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this non-statutory double patenting rejection is based on the above-listed applications which are all commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

### **35 U.S.C. § 102 REJECTIONS**

The Examiner rejects claims 1, 2, 8, 9, 11, 12, 15, 18, and 19 under 35 U.S.C. § 102(e) as being anticipated by Black, U.S. Patent Application No. 2005/0122209 ("Black"). The Examiner notes that, "Re claim 1 Black (US 2005/0122209) teaches a smartcard transaction system configured with a biometric security system, the system comprising: a smartcard configured to communicate with a reader; a reader configured to communicate with the system; a biometric sensor configured to detect a proffered biometric sample, the biometric sample configured to communicate with the system; and, a device configured to verify the proffered biometric sample to facilitate a transaction" (Page 10). Applicants respectfully traverse this rejection.

In general, Black discloses an identity authentication system comprising a device for capturing a customer signature. Black requires a user to provide an electronic signature using a stylus or other similar device ([0016], [0022]). Further, while Black discloses submitting personal data during the registration procedure (Fig. 5A), Black only discloses such personal data to be customer record numbers, customer bank, account numbers, account balance, reference prints and reference signatures (Fig. 10A-B, 11A-B). Black is silent as to providing smartcard information, not because such information is obviously provided, but because Black does not enable both biometric registration and payment. Rather, Black merely provides *access* to a payment account "when the sensed digital signature matches a reference digital signature" ([0020]).

Further still, Black is limited to associating a single transaction account with the customer record (Figs. 10A-B, 11A-B, [0087]). That is, Black is limited to having a smartcard consisting of only one "customer account that is to be used for payment" ([0084]), and not a smartcard with multiple credit and/or debit accounts. Thus, Black does not teach or disclose at least "a verification device configured to verify said proffered biometric sample to facilitate a payment

transaction using an account, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account,” as recited in independent claim 1.

Claims 2, 8, 9, 11, 12, 15, 18 and 19 indirectly and directly depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 2, 8, 9, 11, 12, 15, 18 and 19 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2, 8, 9, 11, 12, 15, 18 and 19.

### **35 U.S.C. § 103 REJECTIONS**

#### ***Rejections Under 35 U.S.C. § 103(a)—the Black and Janiak References***

The Examiner rejects claims 3-7, 10 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Black. Applicants respectfully traverse this rejection.

As discussed above, Black is limited to associating a single transaction account with the customer record (Figs. 10A-B, 11A-B, [0087]). That is, Black is limited to having a smartcard consisting of only one “customer account that is to be used for payment” ([0084]), and not a smartcard with multiple credit and/or debit accounts. Thus, Black does not teach or let alone suggest at least “a verification device configured to verify said proffered biometric sample to facilitate a payment transaction using an account, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account,” as recited in independent claim 1.

Claims 3-7 and 10 indirectly and directly depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 3-7 and 10 are differentiated from the cited reference at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3-7 and 10.

The Examiner additionally cites, regarding claim 17, Janiak et al., U.S. Patent Application No. 2002/0097142 (“Janiak”) for “provid[ing] notification that a sample has been

detected, to provide indication to the user.” (Page 14). Applicants respectfully traverse this rejection.

Neither Black, Janiak, nor any combination thereof, teach or disclose at least “a verification device configured to verify said proffered biometric sample to facilitate a payment transaction using an account, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account,” as recited in independent claim 1. Moreover, claim 17 directly depends from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claim 17 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 17.

***Rejections Under 35 U.S.C. § 103(a)—the Black and Maritzen References***

The Examiner rejects claim 13 under 35 U.S.C. 103(a) as being unpatentable over Black, as discussed above, in view of Maritzen, et al., U.S. Patent Application No. 2002/0191816 (“Martizen”). Applicants respectfully traverses this rejection.

Neither Black, Maritzen, nor any combination thereof, teach or disclose at least “a verification device configured to verify said proffered biometric sample to facilitate a payment transaction using an account, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account, a debit card account, a savings account, a private label account and a loyalty point account,” as recited in independent claim 1. Moreover, claim 13 indirectly and directly depends from claim 1 and contains all of the elements thereof. Therefore, Applicants respectfully submit that claim 13 is differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 13.



***Rejections Under 35 U.S.C. § 103(a)—the Black and Moebs References***

The Examiner rejects claim 14 as being unpatentable over Black, as discussed above, in view of Moebs et al, U.S. Patent Application No. 2005/0065872 ("Moebs"). Applicants respectfully traverse this rejection.

Neither Black, Moebs, nor any combination thereof, teach or disclose at least "a verification device configured to verify said proffered biometric sample to facilitate a payment transaction using an account, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account," as recited in independent claim 1. Moreover, claim 14 directly depends from claim 1 and contains all of the elements thereof. Therefore, Applicants respectfully submit that claim 14 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 14.

***Rejections Under 35 U.S.C. § 103(a)—the Black, Goodman, and Haala References***

The Examiner rejects claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Goodman, U.S. Patent Application No. 2002/0043566 ("Goodman"). The Examiner additionally cites Haala, U.S. Patent Application No. 2005/005172 ("Haala '172) and U.S. Patent Application No. 2005/0102524 ("Haala '524) to support this rejection. Applicants respectfully traverse this rejection.

Neither Black, Goodman, Haala '172, Haala '524, nor any combination thereof, teach or disclose at least "a verification device configured to verify said proffered biometric sample to facilitate a payment transaction using an account, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account," as recited in independent claim 1. Moreover, claim 16 directly depends from claim 1 and contains all of the elements thereof. Therefore, Applicants respectfully submit that claim 16 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 14.

**CONCLUSION**

Applicants respectfully submit that the pending claims are in condition for allowance. No new matter is added in this Reply. Reconsideration of the application is thus requested. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814. Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,

Dated: September 7, 2005

By: 

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